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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,139	10/09/2001	Paul W. Rockley	2730	4692

26822 7590 08/27/2003  
WALTER A. HACKLER  
2372 S.E. BRISTOL, SUITE B  
NEWPORT BEACH, CA 92660-0755

EXAMINER

DAVIS, DANIEL J

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 08/27/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/973,139

Applicant(s)

Examiner

D Jacob Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE 7/25/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-13,15,7-20 and 22-27 is/are rejected.
- 7) ☒ Claim(s) 7,14,21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation "the first needle" in line 4. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 15, 17, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rainin (US 5,569,279). Rainin discloses an instrument for the removal of lens tissue (Figs. 1-3) comprising a first instrument 100, a second instrument 50 having a tool 12, and a port comprising the distal end of the second instrument. The second

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instrument comprises a conduit 46 attached a shaft 36. The tip of the second instrument is transverse to the shaft and is generally in the shape of a hook.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rainin in view of McCabe et al. (US 5,562,640). Rainin fails to disclose a plurality of irrigation ports in the irrigation instrument. Nevertheless, McCabe teaches the use of a general surgical instrument used in irrigating and aspirating a surgical site. The irrigation channel comprises a plurality of holes 44, which more efficiently irrigate a surgical site. Although the instrument is a general surgical instrument and is silent regarding its application to cataract surgery, one of ordinary skill in the art of irrigating and aspirating would look to the general surgical art to more efficiently irrigate during cataract surgery. This fact is implicitly taught by McCabe who makes reference to irrigation and aspiration in cataract surgery (Col. 2, lines 37-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to alter the Rainin device as taught by McCabe to further comprise a plurality of holes in the irrigation instrument to irrigate more efficiently.

Claims 8, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rainin in view of Evvard. Rainin is silent regarding the use of ultrasonic vibration. Nevertheless, Evvard discloses the use of an instrument that is ultrasonically vibrated to more efficiently break up the cataract. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply ultrasonic vibratory energy to the second instrument 50 to more efficiently break up a cataract.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rainin in view of Evvard and in further view of McCabe. The Rainin/Evvard device fails to disclose multiple holes. An explanation and motivation for adding the holes to the device can be found in the explanation of claims 5 and 19.

***Allowable Subject Matter***

Claims 7, 14, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 22-27 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Response to Arguments***

Applicants' arguments regarding Evvard's tip as being a solid blade are considered persuasive. The arguments regarding Rainin's first instrument 100 are not deemed persuasive since the device *could* perform fragmentation, at least to some degree. McCabe makes reference to cataract surgery in the specification, thus providing evidence that one of ordinary skill in the art of cataract irrigation and aspiration would know to look to references within the general surgical art and not only within the art of cataract surgery.

Applicants' arguments regarding the Rainin device being used in conjunction with ultrasonic energy are not deemed persuasive. Applicants do not expound as to how all ultrasonic energy must be absorbed at all effecting times. Examiner contends that such would not always be the case since the device may be held a certain distance from the target area that would not absorb all of the energy. Rainin states that the device is used to abrade biological material. Hence it would be desirable to use ultrasonic energy to more effectively abrade the material.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

DJD  
August 23, 2003

*Julian W. Woo*  
Julian W. Woo  
Primary Examiner